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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,199	08/31/2001	Jan Ingemar Swerup	34649-00461USPT	4505

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EXAMINER

SMITH, CREIGHTON H

ART UNIT PAPER NUMBER

2645

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

945199

Applicant(s)

Swerup et al

Examiner

Smith, C.H.

Group Art Unit

2645

---The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address---

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-56 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-56 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

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## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Claims 1- 56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 is vague and indefinite because in line 2, applicant claims that a call has been established. Then in lines 3-6 applicant claims that the writing surface mode change condition establishes the call. how can the writing mode change condition establish a call if the call has already been established, as previously claimed in line 3? Applicant has basis the spec for a control unit 32 that can toggle between a display screen and a writing surface. The spec is also deficient because on page 4 , lines 1-2, applicant discloses that the writing surface change condition establishes the call. Applicant has basis in the spec on page 7 for "...upon establishment of a call...the control unit 32 causes the screen 26 to automatically enter into the writing-surface mode so the that the user of the mobile station 10 can easily write notes during the call without having to operate a menu or other navigation system." "[Alternatively], "the control unit 32 does not cause the device 14 to enter into the writing surface mode until button 28 of the device is pressed. Therefore, to claim that the writing mode change condition "establishes a call" seems inaccurate because the control unit will allow the user to switch from a display screen to a writing surface/ screen by depressing the control unit's button for such purpose, AFTER the call has been established.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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Art Unit: 2645

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1- 56 as understood are rejected under 35 U.S.C. 102(e) as being anticipated by de Casillas, Linge, or Shin et al.

All three references teach applicant's concept of utilizing a writing surface in conjunction with a mobile phone.

Any inquiry concerning this communication should be directed to Creighton H Smith at telephone number 308-2488.

22 JULY '04



Creighton H Smith  
Primary Examiner  
Art Unit 2645